

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:)	
)	
Risan et al.)	Confirmation No.: 6735
)	
Application No.: 10/661,047)	
Patent No.: 7,584,353)	
)	
Filing Date: 09/12/2003)	
)	
For: Preventing Unauthorized Distribution of)	
<u>Media Content within a Global Network</u>)	

Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: BASIS(ES) UNDER
1.702 FOR THE ADJUSTMENT (37 C.F.R. 1.705(b)(2)(i) and (ii))

1. This statement is being submitted in support of the "Request for Reconsideration of Patent Term Adjustment Indicated in Issue Notification" to which this statement is attached.

37 C.F.R. 1.705(b)(2)(i)

2. The patent term adjustment shown on the Issue Notification is: 837 days. It is respectfully suggested that the correct patent term adjustment under 1.702 is: 1176 days.

37 C.F.R. 1.705(b)(2)(ii)

3. Under 1.705(b)(2)(ii) applicant must set forth: "The relevant dates as specified in 1.703(a) through(e) for which an adjustment is sought and the adjustment as specified in 1.703(f) to which the patent is entitled." The three year date begins on 09/12/2006, which is three years after the date of application. The adjustment is sought for the following date range: between 04/03/2007 and 03/07/2008. Adjustment to be made for this date range: 339 days.

The basis on which the Petitioners seek adjustment is as follows: A First Action on the merits was received 872 days after the 14-month date. The 3-year rule to allowance was violated by 339 days (from 04/03/2007 and 03/07/2008) that did not overlap with the 14-month violation of 872 days. Subtraction of applicant delays of 3 and 5 days reduces the 3-year delay from 339 days to 331 days. It is appreciated, however, that these and other applicant delays have already been accounted for in the 837 days of adjustment that was indicated in the issue notification. Per *Wyeth v. Dudas* (580 F. Supp. 2d 138; 88 U.S.P.Q.2D (BNA) 1538, September 30, 2008), the USPTO's view that any administrative delay under 35 U.S.C.S. §154(b)(1)(A) overlapped any three-year maximum pendency delay under § 154(b)(1)(B) could not be squared with language of § 154(b)(1)(B), as "B delay" began when PTO had failed to issue patent within three years, not before. As the instant patent was not issued within three years of filing and includes non-overlapping periods of both 14-month rule delay and 3-year rule delay, Petitioners submit that the holding of *Wyeth v. Dudas* should be applied in the calculation of PTA. In accordance with this ruling (which is presently being appealed by the USPTO) Petitioners submit that the total PTA should = 872 days (14 month delay) + 331 days (3 year delay) - 27 days (other applicant delay), for a total of 1176 days, rather than the 837 days indicated on the issue notification.

Respectfully submitted,

WAGNER BLECHER LLP

Dated: November 2, 2009

/John P. Wagner, Jr./

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I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300 or via electronic submission.

Typed Name: Brenda Dinapoli

Date of Deposit: 2 Nov 2009

Signature: /Brenda Dinapoli/

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Request for Reconsideration of Patent Term Adjustment Indicated in Issue Notification

Dear Sir:

In response to the Issue Notification, which established an issue date of 9/01/2009, Petitioners respectfully request review of the calculated Patent Term Adjustment to ensure that an error was not made. This Request/Petition is being filed pursuant to 37 CFR §1.705(d) and in accordance with the requirements of paragraphs (b)(1) and (b)(2) of the same section. Please consider the following remarks.

REMARKS

1. This request, filed under 37 CFR §1.705(d), is for reconsideration of the patent term adjustment indicated in the Issue Notification. Petitioners submit that, at issuance, the patent term adjustment should have reflected a revised patent term adjustment that was greater than the amount of patent term adjustment indicated in the notice of allowance. These issues raised herein are due to three-year violations under 37 C.F.R. §1.702(b). It would have been untimely to raise this matter prior to issuance. Indeed, on 27 July 2009, the Office of Petitions “... **DISMISSED as PREMATURE**” (emphasis in original) a petition for patent term adjustment which was filed following notice of allowance, but prior to receiving the notice of issuance.

2. Petitioners submit herewith, as an attachment, a “Statement of the Correct Patent Term Adjustment: Basis(es) under 1.702 for the Adjustment,” that is in compliance with 37 CFR 1.705 (b)(2).

3. The instant issued patent is not subject to a terminal disclaimer.

4. As to circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 1.704 (37 C.F.R. 1.705(b)(2)(iv)), there were as follows (37 C.F.R. 1.705(b)(2)(iv)(A)):

- 11/07/2007, Applicant delay of 5 days in filing response to non-final Office Rejection;
- 03/07/2008, Applicant delay of 3 days in filing RCE;
- 03/07/2008, filing of RCE;
- 03/18/2009, Applicant delay of 27 days in filing RCE; and
- 03/18/2009, filing of RCE.

5. The fee set forth in 1.18(e) (\$200.00), required by 37 C.F.R. 1.705(b)(1), is paid as follows: please charge Deposit Account 50-4157 for the \$200.00 fee. Additionally, at any time during the review of this request/petition, please charge any fees required or credit any over payment to Deposit Account 50-4157 pursuant to 37 CFR 1.25.

Respectfully submitted,

WAGNER BLECHER LLP

Dated: November 2, 2009

/John P. Wagner, Jr./

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